UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,602	02/27/2004	Josef Gluch	2002 P 50357 US	6795

			EXAMINER
48154	7590	07/05/2006	COSIMANO, EDWARD R

SLATER & MATSIL LLP
17950 PRESTON ROAD
SUITE 1000
DALLAS, TX 75252

ART UNIT	PAPER NUMBER
2863	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/788,602	GLUCH, JOSEF
	Examiner	Art Unit	
	Edward R. Cosimano	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-17</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>27 February 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/21/04</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   The Oath/Declaration filed 28 June 2004 and the Abstract as originally filed are acceptable to the examiner.

2.   The sheet of drawings filed on 27 February 2004 containing figs. 1 & 2 is acceptable to the examiner.

3.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

4.   How Claims are to be interpreted during the prosecution of an application for patent.

4.1   The pending claims are interpreted by giving the language of every positively recited limitation of the pending claims the broadest reasonable interpretation that is consistent with how one of ordinary skill at the time of the invention would have interpreted the language of the claims, In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), while (1) taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification, In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), and (2) without reading unrecited limitations   from   applicant's   disclosure   in   to   the   claims,   see In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969) "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.", In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969).

4.1.1   Further, when interpreting the claims as a whole, then the interactions of claim limitations as a whole must be considered in order to determine the scope of a claim and the applicant's contribution in the art, In re LARSEN, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) "The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art.". Where a statutory process/machine must contain an operative series of acts/functions or structures, In re MUSGRAVE, 167 USPQ 280 at 289-290 (CCPA 1970), with explicitly recite all of the necessary interactions to accomplish the recited utility of the claimed invention, for without these interaction the claim as a whole would not be a proper process/machine under the statue, In re SARKAR 200 USPQ 132 at 136 (CCPA 1978).

4.1.2   In regard to the limitations on the interpretation of the claimed invention as imposed by the Court, it is noted that applicant has gone to great lengths in the written description to describe each of the disclosed means or acts by not describing a specific structure for each of means or a specific act but by describing the means or act by describing the function of each of the means or acts. Hence, it is noted that as set forth by the Court each of the limitations of the claims could be reasonably interpreted by one of ordinary skill at the time of the invention as not being not limited to the corresponding disclosed structure/act but in fact would to be broadly interpreted to include any and all means that would provide the corresponding functions or acts that are recited as the claimed invention.

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.1   Claim(s) 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5.1.1   During the following analysis the following principles have been applied:

> A) the limitations of the specification may not be read into the claims, "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement   of   the   limitation   is   included   in   the   claim.", In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969); and

> B) that a computer readable media containing data/information that would cause a useful function to be performed when claimed in conduction with a computer in such a manner that the functionality recited as the invention can be realized are statutory, see MPEP 2106(IV)(B)(1)(a) and In re BEAUREGARD, 35 USPQ2d 1383 (CAFC 1995), and note the corresponding claims of Beauregard et al (5,7010,578); and

> C) that data structures by definition are not programs, "(The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).)", see also MPEP 2106(IV)(B)(1); and

D) concerning statutory subject matter, as set forth in the following quote, the computer program running on a computer makes the computer a different machine, see In re ALAPPAT, 31 USPQ2d 1545 at 1558 (CAFC 1994), "We have held that such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software."; and

E) methods of operating a computer are statutory unless they fall in to judicially exceptions, see In re CHATFIELD, 191 USPQ 730 @ 736 (CCPA 1976) "Because Chatfield's claim 1 defines the invention as a "method of operating a computing system upon more than one processing program * * * comprising," the claim prima facie is directed to a "method" and the wording of the claim would bring it within the statutorily defined "process" category. However, a claim to a "method" or "process" may fall within the literal terms of the statute and yet not define proper subject matter for patent protection. Benson and Christensen, supra. The question is whether the claimed method falls within either of two categories judicially determined to be non-statutory ...."; and

F) that a computer program is not a statutory process since the program alone can not bring about a useful result with out being claim as being executed by a computer, see MPEP 2106(IV)(B)(1)(a); and

G) that nonfunctional data stored in a memory device is non-statutory, see "When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re SARKAR, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978)".

5.1.2   It is noted that:

A) claim(s) 1-6 & 9-17 are directed to a "program" per se as set forth by applicant in the preamble and hence these claims recite steps/functions/actions that when take as a whole do not define either a process, see MPEP 2106(IV)(B)(1)(a), and In re CHATFIELD, supra, or a machine, see In re ALAPPAT, supra; and

B) claim(s) 7-8 are directed to an interfacing "program" per se as set forth by applicant in the preamble and hence these claims recite steps/functions/actions that when take as a whole do not define either a process, see MPEP 2106(IV)(B)(1)(a), and In re CHATFIELD, supra, or a machine, see In re ALAPPAT, supra.

5.1.3   It is further noted that:

A) claim(s) 1-17 when take as a whole are directed to a program or process/method that does not achieve the claimed utility of interfacing since as one of ordinary skill at the time the invention was made would recognize these claims fail to recite the structure that would be necessary to implement the functions of the recited "program" or "code" so as to achieve the disclosed and recited utility of the claimed invention.

5.1.4   In regard to each of the pending claims taking each claim as a whole and interpreting the claims as set forth above, one of ordinary skill at the time of the invention would make the following observations in regard each of the limitations of the claims:

A) process claims 1-6 & 9-17 recite an intended field of use of "a test system for testing an integrated circuit" but fail to recite a limitation that the operation of the test system is in anyway affected by the claimed process of claims 1-6 & 9-17;

B) the process claims 7-8 recite an intended field of use of "communicating in a test system for integrated circuits" but fail to recite a limitation that the operation of the test system is in anyway affected by the claimed process of claims 7-8;

C) the claims recite a utility of "a program" claims 1-6 & 9-17 and "code" claims 7-8" for interfacing components in a testing system;

D) in regard to the body of claims 1-17, as recited in these claims applicant has:

(1) set forth a "software program" in claims 1-6 & 9-17 comprising "computer program code for" performing one or more functions that manipulate numbers by converting a number/code into another number/code and transferring data/information with in a system; and

(2) set forth an "interfacing program" in claims 7-8, comprising "high-level code" and "low-level code" for performing one or more functions that manipulate numbers by converting a number/code into another number/code; and

(3) failed to set forth either (a) a specific machine that is operates in a specific manner by executing the recited "program" or "codes" so as to produce a new machine, see In re ALAPPAT, supra, or (b) a process of operating a machine to perform the recited functions of the "program" or "code", see In re CHATFIELD, supra.

Hence, as one of ordinary skill at the time the invention was made would recognize, the language of the claims merely recites functions that the program/code or data/information is intended to accomplish as the invention but fails to recite any limitation that would permit the functionality of the recited program/code or data/information to produce the concretely and tangibly result. Therefore, one of ordinary skill at the time the invention was made would recognize the recited functional language of the claims as being non functional descriptive material/data/information upon which patentability can not be based, "Cf. In re GULACK, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: ... - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material." MPEP 2106.

5.1.5   In view of the above characterization of claim(s) 1-17 it can clearly be seen that, as these claims would be reasonably interpreted by one of ordinary skill at the time the invention was made, these claims merely convey to one of ordinary skill at the time the invention was made a description of an invention that merely sets forth the concept of data/information, that is a program/code/instructions, as non functional data/information that may be contain with in a type

of memory or machine, where the recited machine in and of itself can not realize the disclosed and claimed utility as set forth by applicant.

5.1.6 Such a claimed invention as recited in the claims, as would be recognized by one of ordinary skill at the time the invention was made, as describing a claimed invention that is not operative to achieve the disclosed or claimed practical and substantial utility of "interfacing systems" as applicant has set forth and has been by the court to be non-statutory subject matter, see In re SARKAR, supra.

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1   Claims 1-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Stubbs (4,812,996).

6.1.1 In regard to claims 1-17, Stubbs ('996) discloses a computer implemented process/machine that under the control of an operating program stored in a computer accessible storage device provides the function of remotely controlling a machine/process for testing something through an interface. To this end Stubbs ('996) discloses computer 32 with memory 34 and display 36 and input device 38. When an user/operator at computer 32 desires to perform a test on an item using a test instrument 42, the control software program stored in memory 34, that is the operating system, presents the user with a graphical representation of the test instrument.   Using input device 38 the user enters the necessary high level generic test instructions/data/information that are required for instrument 42 to perform the desired test on the item. Once the required generic test instructions have been entered by the user computer 32 under the control of the control software program stored in memory 34 performs the task of an interface by converting the user's generic test instructions into the specific control commands that are necessary for instrument 42 to perform the desired test. Still performing the function of an interface computer 32 sends the required control instructions to instrument 42 using a communications link 40. Instrument 42 under the control of it's own operating system is

configure to store the received command instructions in the memory of the test instrument and to execute the stored commands to perform the desired test. After the desired test is complete, instrument 42, under the control of it's operating system, communicates the test results to computer 32. The computer 32 presents/displays the received communicated test results to the user via display 36 under the control of the operating system of computer 32.

6.1.2 It is further noted that as taught by Stubbs ('996) the test instrument could be any remotely programmable test Instrument.

6.1.3 In regard to claim(s) 1-17, it is further noted that the combination of the operating program that is stored with in the memory of the machine of Stubbs ('996) and controls the machine/process of Stubbs ('996) would be recognized by one of ordinary skill at the time the invention was made as the invention recited in these claims.

7.   The examiner has cited prior art of interest, for example:

A) Kink et al (3,200,379) discloses that computers are controlled by instructions written in a low level programming language, where the instructions consisting of a multi part code that tells the processor what instructions/operations are to be performed. And further that before programmers can properly program a computer, the programmer must learn and use high level programming languages to describe the desired function to be performed by the computer. The function described by the high level language is then compiled of converted into the corresponding instructions/operations that the computer can understand and execute so that the computer will perform the function described by the programmer in the high level programming language.

B) Topp, Jr. et al (3,219,927) discloses that programmed computers can be used to control the operation of a testing instrument/system to take measurements and present the results to an operator faster than would be possible if these functions were performed manually.

C) Lowell et al (4,057,847) discloses a remotely controlled tester that receives and executes testing commands from a remote data processing unit.

D) Motoyama (5,818,603) disclose that when a computer controls the operation of a number of different devices that communicate using different languages/formats the computer detects the type of format being used for received messages based on stored

formats and uses the assigned format for a device to send information to the remotely controlled device.

E) either Gritzbach et al (2002/0062068 or JP 2002-224046) disclose a machine/process in which a central control system remote controls a number of different types of monitoring equipment by generating when necessary device specific control codes/commands for each device and then presents the received results from the controlled device to the user.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward R. Cosimano whose telephone number is 571-272-0416. The examiner can normally be reached on 571-272-0571 from 7:30am to 4:00pm (Eastern time).

8.1   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8.2   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERC
06/20/2006

Edward Cosimano
Primary Examiner